



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/117,970	08/07/98	FINN	D 59276

MC GLEW AND TUTTLE
SCARBOROUGH STATION
SCARBOROUGH NY 10510-0827

QM12/0811

EXAMINER

ARBES, C

ART UNIT	PAPER NUMBER
----------	--------------

3729

DATE MAILED:

08/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

9/117 820

Applicant(s)

Finn et al

Examiner

C. J. Arbes

Group Art Unit

3229

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on June 6, 2000

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 40-67 and 78-82 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 78 is/are allowed.

☒ Claim(s) 40-43, 46, 47, 49, 51, 53, 62-67, 79 and 80 is/are rejected.

☒ Claim(s) 44, 45, 48, 50, 52, 54-61, 81 and 82 is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 3729

Claim 53 recites the limitation "relative to the wiring device" in the third line thereof.

There is insufficient antecedent basis for this limitation in the claim.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-43, 46-47, 49, 51, 53, 62-67, 79 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/07984 by Mundigl et al hereinafter '984. The '984 teaches a process of making a smart card module for a contact less smart card wherein wire is placed onto a substrate so as to form a coil and the ends of the wire are connected to a chip. It would have been obvious to connect the wires to the chip by means of a connecting instrument if indeed the '984 does not expressly teach the same inasmuch as this would be the expedient and quickest way to do this step. As applied to Claims 41, 42, 51, 62, 66 and 67, it is held that the use of an ultrasonic means to as Applicant advance no purpose therefore nor provide any problem which is solved. Moreover the limitation of using ultrasonic means to bond wires onto a substrate such as applicants recite is known in this art and hence is held to have been obvious to one of ordinary skill in the art.

Art Unit: 3729

Claims 44, 45, 48, 50, 52, 54-61, 81 and 82 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Claim 78 is held to be allowable.

It appears that one of Applicants' foreign priority documents viz. German Pat. No. 196 04 840.0 with a date of February 12, 1996 may precede the teaching used for this rejection. Applicants again are requested to finish an English translation of this document to ascertain the content therefore.

Applicants' Amendment filed June 6, 2000 has been carefully considered however it has not effected any change on the Examiner's original determination of patentability of claims 40-43, 46, 47, 49, 50, 53, 62-67. Moreover claims 79 and 80 also are held to lack patentable subject matter. Although applicants urge that Claims 40 and new claim 79 set forth a specific order for the process of the present invention this is not clearly recited in these claims. Even assuming claims 40 and 79 set forth a specific order for the steps (or ^{phases} ~~phases~~) of the method nevertheless it would have been obvious to one of ordinary skill in this art at the time this application was filed to connect the wires ends the chip.

Art Unit: 3729

Any inquiry concerning this communication should be directed to C.J. Arbes at telephone number (703) 308-1857.


Carl J. Arbes
Primary Examiner

C. ARBES:th
August 4, 2000